

## **REMARKS**

### **Claim Status**

Claims 1-53, 66-72, and 86-88 are pending in the Application. This paper amends claims 1, 21, 39, 52, and 53; and adds new claim 88. Claims 1, 21, 39, 45, 48-53, 66, and 70 are the independent claims of the application.

### **Rejections Under 35 U.S.C. § 112**

The Office Action rejected claims 21, 52, and 53 under 35 U.S.C. § 112. In particular, the Office Action pointed out that “the applicant states in the preamble that the invention is a method and system for searching intellectual property listings,” but “there is no searching step in the claim language.” Claims 21 and 52 have been amended to recite a step of searching. Claim 53 has been amended to recite means for searching. Applicant respectfully submits that the amendments of these claims obviate the rejections entered under section 112.

### **Rejections Under 35 U.S.C. § 101.**

The Office Action rejected claims 1-16, 19, 20, and 39-44 under 35 U.S.C. § 101 as “directed to non-statutory subject matter” and “recit[ing] an abstract idea.” In particular, the Office Action stated that “[t]he recited steps . . . do[] not apply, involve, use, or advance the technological arts since all the recited steps can be performed in the mind of the user or by use of a pencil and paper.” Applicant respectfully traverses these rejections.

Independent claims 1 and 39 (the only independent claims among claims rejected under section 101) are directed to methods of searching listings. Whether the steps of the methods can be performed mentally or using pencil and paper is not determinative of the claims' status as patentable subject matter. "The inclusion in a patent of a process that may be performed by a person, but that also is capable of being performed by a machine, is not fatal to patentability." *Alco Standard Corp. v. Tennessee Valley Authority*, 808 F.2d 1490, 1 U.S.P.Q.2d 1337 (Fed. Cir. 1986), *cert. dismissed*, 483 U.S. 1052 (1987).

Furthermore, even a process that merely manipulates an abstract idea or performs a purely mathematical algorithm (which characterization does not apply to claims in issue here) falls within statutory subject matter if it is limited to a practical application of the idea or algorithm in the technological arts. MPEP §2106(IV)(B)(2)(b)(ii) (*citing In re Alappat*, 33 F.3d 1526, 1543 (Fed. Cir. 1994)). "A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result; . . . Likewise, a machine claim is statutory when the machine, as claimed, produces a concrete, tangible and useful result." MPEP §2106(IV)(B)(2)(b)(ii) (*citing State St. Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373 (Fed. Cir. 1998)). In the methods of claims 1 and 39, listings are searched according to user-provided search criteria, a resulting set of listings is presented to the user, and an identification of one or more of the listings in the resulting set that are of interest to the user is received from the user. These are concrete, tangible, and useful results, not mere abstractions.

Finally, Applicant notes that it is not at all clear how the step of "maintaining a user-interface site" can be performed solely "in the mind of the user or by use of a pencil and paper." If the section

101 rejection is maintained, Applicant respectfully requests that an appropriate explanation be provided in the next Office action.

Anticipation Rejections

*Claim 1*

Claims 1, 4, 8-10, and 20 were rejected under 35 U.S.C. § 102(e) as being anticipated by Lundberg, U.S. Patent Publication Number 2002/0091541 (“Lundberg” hereinafter). According to the Office Action, Lundberg teaches all limitations of independent claim 1 in figures 1 and 2, and in numbered paragraph 0009.

As amended, independent claim 1 recites a step of “establishing a connection to a plurality of third-party sources of intellectual property listings available for transacting.” Lundberg does not disclose listings available for transacting. Lundberg describes

retrieving or selecting a set of IP asset records from a source database of IP asset records 16 (FIG. 1) for example including all patents or trademarks issued or handled by an organization such as the United States Patent & Trademark Office, or the European Patent Office, or any other country's patent and trademark offices.

Lundberg, par. 0007. The United States Patent & Trademark Office, the European Patent Office, or any other country's patent and trademark offices, however, do not list intellectual property that is necessarily available for transacting. To the contrary, official patent and trademark databases typically list all or most patent documents or trademarks. In such databases, no distinction is made between the listed patents that are available for transacting (*e.g.*, sale or license) and those that are not available for transacting. Official patent and trademark databases are not “sources of intellectual property listings available for transacting.” At least for this reason, independent claim 1 is not anticipated by Lundberg.

*Claim 4*

Claim 4 was rejected because, according to the Office Action, Lundberg's figures 1 and 2 disclose the step of "establishing contact between said at least one of said plurality of users and those of said plurality of third-party sources including those of said resulting set of intellectual property listings which are of interest to said at least one of said plurality of users." Applicant respectfully submits that Lundberg does not disclose such step in either of these figures. Indeed, it appears that Lundberg's figure 1 does not disclose any steps. As regards figure 2, it appears that none of the steps involves establishing contact between a user and a third-party source. For example, the step of automatically adding to user portfolio does not inherently require contact between the user and a third-party source. At least for this reason, Lundberg does not teach all of the limitations of dependent claim 4.

*Claims 8-10*

In rejecting claims 8-10, the Office Action asserts that Lundberg discloses all of the additional steps of these claims in figures 1 and 2. As has already been mentioned, Lundberg's figure 1 apparently does not disclose any steps. Furthermore, the steps of "reformatting said search criteria" (claim 8), "reformatting said intellectual property listings" (claim 9), or "reordering said intellectual property listings" (claim 10) are not expressly disclosed in Lundberg's figure 2. These steps-limitations are also not inherent in Lundberg.

As regards the step of "reformatting said search criteria according to requirements of each of said plurality of third-party sources of intellectual property listings" in claim 8, this step is not necessarily required in Lundberg's method and system. For example, the user may be required to

submit the search criteria in the format(s) appropriate to the third-party sources, thus obviating any potential need to reformat the user's search criteria.

Regarding claim 9, the step of "reformatting said intellectual property listings stored in said buffer memory in a predetermined format prior to presentation thereof to said at least one of said plurality of users" is also not strictly required by Lundberg. For example, the listings may be displayed in their original format, that is, without reformatting.

Regarding claim 10, the step of "reordering said intellectual property listings stored in said buffer memory according to predefined criteria prior to presentation thereof to said at least one of said plurality of users" is similarly not strictly required. The listings may be displayed, for example, in the order received.

At least for these reasons, Lundberg does not disclose the additional limitations of claims 8-10, either expressly or inherently.

#### Claim Rejections Under Section 103

##### *Claims 21-39 and 45-53*

Claims 21-39 and 45-53 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tran, U.S. Patent Document Number 2002/0095368 ("Tran" hereinafter). Applicant respectfully traverses these rejections.

The Office Action states that Tran discloses the step of "maintaining access to a predetermined set of third-party sources of intellectual property listings searchable online" in the Summary section, *i.e.*, in paragraphs 0006-0012. It appears, however, that in the cited portion and elsewhere, Tran does not disclose more than a single source of listings. Moreover, the single source

is not a third-party source. Rather, the single source of listings is the very system described in Tran. See, for example, multiple references to “the system” in Tran’s Summary section, numbered paragraphs 0006-0012. Tran therefore does not disclose the step of “maintaining access” as recited in claim 21, or the step of “establishing a connection to a plurality of third-party sources” as recited in claim 39.

Further, the Office Action acknowledges that Tran does not disclose “taking a snapshot of each of said third-party sources of intellectual property listings, storing said snapshots in said first memory storage area, reformatting each of said snapshots in a predetermined format, and storing said reformatted snapshots in said second memory storage area.” The Office Action then states that “[t]he fact that the data is stored by making a snapshot is a design choice and would have been obvious.” Invoking “design choice,” however, does not obviate the need to provide sufficient reasoning in support of an obviousness rejection. To make a *prima facie* case of obviousness, the Office must provide reasoning why a specific feature is a “design choice” and therefore obvious. *In re Chu*, 66 F.3d 292, 36 U.S.P.Q.2d 1089 (Fed. Cir. 1995). Such reasoning has not been provided here.

At least for these reasons, claims 21-39 and 45-53 are patentable over Tran.

*Claims 40-43, 66-70, 86, and 87*

These claims were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lundberg in view of Tran. The Office Action acknowledged that certain limitations of the claims are not disclosed by Lundberg, and sought to import these limitations from Tran. Applicant respectfully traverses these rejections because the Office Action does not point out what would motivate a person skilled in the art to combine the references.

The Patent and Trademark Office has the initial burden of making a *prima facie* case of obviousness. *E.g.*, *In re Mayne*, 104 F.3d 1339, 1342 (Fed. Cir. 1997); MPEP § 2142. For a *prima facie* case of obviousness, the prior art must teach or suggest all limitations of the claim. *In re Mayne*, 104 F.3d at 1341 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966)); MPEP § 2143. Further, the prior art must suggest the combination or method claimed and reveal a reasonable expectation of success. *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991); MPEP § 2143.02. “Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant’s disclosure.” *In re Vaeck*, 947 F.2d at 493.

In rejecting claims 40-43, 66-70, 86, and 87, the Office Action does not offer any explanation of the motivation to combine the references. Therefore, a *prima facie* case of obviousness has not been made.

*Claims 2, 3, 5-7, 11-19, and 27*

Claims 2, 3, 5-7, 11-19, and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lundberg and Tran in view of Magid, U.S. Patent Document Number 2001/0032144 (“Magid” hereinafter). Applicant respectfully traverses these rejections.

In particular, the Office Action asserts that Magid discloses the step of “securing permission from each of said plurality of third-party sources . . . for allowing a search of each said plurality of third-party sources” at page 1, numbered paragraph 0014. For convenience, Magid’s paragraph 0014 is quoted below:

For instance, in a case where there are three viewing stages (see FIG. 1), the first stage that could be termed a surfer stage, would allow rudimentary keyword viewing in exchange for identification and a pin number. The second stage, more sophisticated viewing of technology, may require the purchaser, who is now trying to promote his worthiness of viewing higher levels of disclosure, to sign a disclosure

agreement as to his resources, capabilities, use of the technology, or other such disclosures which may lead to certificate authentication. The third stage, exchanging even more sophisticated viewing, may require the ultimate purchaser, who is now assuming the sellers traditional psychology of having to qualify and provide his worthiness to buy, to sign a non-disclosure, non-usage agreement, or even a non-compete agreement with the owner/licensor of the technology or with the web-based marketing company providing the service of bringing sellers and purchasers together on the internet. This third viewing stage may further be divided into levels of security requiring increasingly stringent levels of purchaser identification or monies paid to achieve successively higher levels in the viewing and evaluating process, which may include an audio/visual presentation/demonstration of the highest levels including know-how transmittals to a now qualified and highly interested potential purchaser/user of the intellectual property.

Magid, par. 0014 (underlining added for emphasis). The agreements discussed in this paragraph include “a disclosure agreement as to [the purchaser’s] resources, capabilities, use of the technology”; and “non-disclosure, non-usage agreement, or even a non-compete agreement.” An agreement for “allowing a search of each said plurality of third-party sources” is not disclosed in the quoted paragraph or, it appears, elsewhere in Magid.

The Office Action further asserts that Magid discloses “securing from each of said plurality of third-party sources of intellectual property listings a fee-sharing agreement,” citing the Summary section of Magid, paragraphs 0013-0021 on pages 1 and 2. We have reviewed the cited text, but have not been able to identify therein a disclosure of a fee-sharing agreement. We also have not been able to identify a disclosure of securing fee-sharing agreements from a plurality of third-party sources of intellectual property listings elsewhere in Magid. It appears that Magid does not disclose such limitations.

Finally, Applicant notes that the Office Action does not explain the motivation to combine the references. Without such motivation, founded in the prior art and not in the Applicant’s disclosure, a *prima facie* case of obviousness has not been made.



At least for the reasons elucidated above, Applicant respectfully submits that claims 2, 3, 5-7, 11-19, and 27 are patentable over Lundberg, Tran, and Magid.

New Claim

Applicant believes that the new claim 88 is patentable together with its base claim, and because the references of record do not disclose or suggest the combination of steps as recited in this claim

**CONCLUSION**

Applicant respectfully submits that all pending claims are directed to patentable subject matter, meet the requirements of 35 U.S.C. § 112, and are patentable over the cited references. To discuss any matter pertaining to the instant application, the Examiner is invited to call the undersigned attorney at (858) 720-9431.

Having made an effort to bring the application in condition for allowance, a notice to this effect is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Anatoly S. Weiser', written over a horizontal line.

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